



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,644	05/09/2001	Peter J. Neumayer	SMUS.0008	3598

32864 7590 10/12/2004
FISH & RICHARDSON, P.C.
3300 DAIN RAUSCHER PLAZA
60 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402

EXAMINER

GART, MATTHEW S

ART UNIT PAPER NUMBER

3625

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,644

Applicant(s)

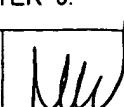
NEUMAYER, PETER J.

Examiner

Matthew s Gart

Art Unit

3625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-19 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-13, 17-19 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/7/2004 has been entered.

Claims 14-16 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention via Paper No. 4. Claims 3, 7, 8, 10, 20 and 25 have been canceled via Paper No. 5. Claims 1, 2, 4-6, 9 and 21 were canceled via Paper No. 7. Claims 11-19 and 22-24 are pending in the instant application.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requires of this title.

Claims 11-19 and 22-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claims 11-19 and 22-24. The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. Claims 11-19 includes the use of technology in a trivial fashion wherein said incoming data is XML based; the claimed incoming data does not structurally affect the underlying method.

Furthermore, claim 17 discloses "automatically acquiring said attributes from another source", this automatic limitation does not necessarily denote a computer implement process, whereby automation can be rule based and implemented without the use of a computer.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 11-13, 17 and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker U.S. Patent No. 6,418,415.

Referring to claim 11. Walker discloses a process of aggregating demands comprising the steps of:

- Validating incoming data in an electronic procurement system so as to ensure said data is valid (at least column 12, line 64 to column 13, line 15);
- Processing said incoming data in the electronic procurement system so as to extract an aggregation rule and at least one demand (at least Fig. 13A, Fig. 13B, and Fig. 13C);
- Processing said aggregation rule so as to apply said aggregation rule against said at least one demand to create at least one group based upon said aggregation rule (at least Fig. 9); and
- Outputting output data indicative of said at least one group (at least Fig. 7).

Referring to claims 12-13. Walker further discloses a process of aggregating demands:

Art Unit: 3625

- Wherein said incoming data is XML based (at least column 9, lines 57-62); and
- Wherein said output data is XML based (at least column 9, lines 57-62).

Referring to claim 17. Walker discloses a process of creating coalitions of demands comprising the steps of:

- Creating a process ID to identify a process through which said coalitions are to be created (at least Fig. 9, Rule Number **1210**);
- Creating groups of demands in an electronic procurement system based upon an application of an aggregation rule (at least Fig.9, CONDITIONS **955**);
- Determining if any attributes of said demands are missing (at least Fig. 13B, Step **1318**);
- If said attributes are missing, automatically acquiring said attributes from another source using the electronic procurement system (at least Fig. 13B, Step **1318**);
- Assigning a unique group ID for each group created and assigning said process ID to said demands (at least Fig. 9, CPO Number **930**);
- Assigning said demands to said coalitions based upon said group IDs (at least Fig. 9, CPO Number **930** and CONDITIONS **955**); and
- Once a predetermined time period has passed, closing said coalitions (at least Fig. 9, AGGREGATE CPO EXPIRATION DATE **950**).

Even though Walker discloses the steps of claim 17 as indicated supra. The Examiner notes, the "if" step of claim 17 is a conditional limitation and is given little patentable weight. Methods are composed of actions, when you perform the actions of a method and do not select one of the alternatives or "if" steps, you are not performing

Art Unit: 3625

any action under those alternatives. Each claim must be separately analyzed and given its broadest reasonable interpretation in light of and consistent with the written description. See, e.g., *In re Morris*, 127 F.3d 1048, 1053-54, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

Referring to claim 22. Walker discloses a process of grouping demands input into a system by a user into coalitions of demands comprising the steps of:

- Inputting demands into a demand aggregation application (at least Fig. 13A, Step **1308**);
- Analyzing said demands by applying an aggregation rule (at least Fig. 13A, Step **1314**);
- If said analysis of said demands indicates that said demands meet criteria of a plurality of coalitions, proposing said plurality of coalitions to said user (at least Fig. 13A, Step **1316**);
- Permitting said user to assign said demands to said one or more of said coalitions (at least Fig. 13B, Step **1324**); and
- If said analysis of said demands indicates that said demands do not meet criteria of any of said coalitions, automatically creating a new coalition to accommodate said demands (at least Fig. 13C, Step **1344**).

Even though Walker discloses the steps of claim 22 as indicated supra. The Examiner notes, the "if" step of claim 22 is a conditional limitation and is given little patentable weight. Methods are composed of actions, when you perform the actions of a method and do not select one of the alternatives or "if" steps, you are not performing

Art Unit: 3625

any action under those alternatives. Each claim must be separately analyzed and given its broadest reasonable interpretation in light of and consistent with the written description. See, e.g., *In re Morris*, 127 F.3d 1048, 1053-54, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

Referring to claim 23. Walker in view of Official Notice discloses a process according to claim 22 as indicated supra. Walker further discloses a process of grouping demands comprising the steps of:

- Determining if any attributes of said demands are missing (at least Fig. 13B, Step **1318**); and
- If said attributes are missing, acquiring said attributes from another source (at least Fig. 13B).

Even though Walker discloses the steps of claim 23 as indicated supra. The Examiner notes, the "if" step of claim 23 is a conditional limitation and is given little patentable weight. Methods are composed of actions, when you perform the actions of a method and do not select one of the alternatives or "if" steps, you are not performing any action under those alternatives. Each claim must be separately analyzed and given its broadest reasonable interpretation in light of and consistent with the written description. See, e.g., *In re Morris*, 127 F.3d 1048, 1053-54, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

Referring to claim 24. Walker discloses a process of aggregating demands according to an aggregation rule comprising the steps of:

Art Unit: 3625

- Collecting at an electronic procurement system demands from a plurality of sources;
- Determining if any attributes of said demands are missing;
- If said attributes are missing, acquiring said attributes from another source;
- Creating in the electronic procurement system groups of demands based upon an application of said aggregation rule (at least Fig. 13A, Fig. 13B, and Fig. 13C); and
- Forwarding said demands to a demand aggregation application (at least Fig. 13B, STEP 1326).

Even though Walker discloses the steps of claim 24 as indicated supra. The Examiner notes, the "if" step of claim 24 is a conditional limitation and is given little patentable weight. Methods are composed of actions, when you perform the actions of a method and do not select one of the alternatives or "if" steps, you are not performing any action under those alternatives. Each claim must be separately analyzed and given its broadest reasonable interpretation in light of and consistent with the written description. See, e.g., *In re Morris*, 127 F.3d 1048, 1053-54, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker U.S. Patent No. 6,418,415.

Referring to claims 18-19. Walker discloses a process according to claim 17 as indicated supra. Walker further discloses a process of creating coalitions of demands comprising the step of permitting automatic addition of additional demands to said coalitions and also permitting coalitions to be automatically closed prior to said predetermined time period passing (at least Figs. 13A, Figs. 13B, and Figs. 13C). Walker does not expressly disclose a process of creating coalitions of demands comprising the step of permitting manual addition of additional demands to said coalitions and also permitting coalitions to be manually closed prior to said predetermined time period passing.

The Examiner notes, the manual process present in the immediate application is considered an obvious variation of the method of Walker. It would have been obvious to a person of ordinary skill in the art at the time of the invention to permit the manual process in lieu of Walker's automatic process, because the manual process results in the same ultimate result and the substitution of the manual process versus the automated process does not otherwise affect the method of Walker. Moreover, the

Art Unit: 3625

applicant has not persuasively demonstrated that permitting a manual step solves any stated problem or is for any particular purpose and it appears that the process of aggregating demands would perform equally well with either a manual or automatic process.

Response to Arguments

Applicant's arguments filed 5/7/2004 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 18-19 are moot in view of the new grounds for rejection.

The Attorney argues that the system as described in Walker is very different from the system claimed in the instant application. The Attorney argues that Walker does not disclose the use of an electronic procurement system. In the context of the instant invention, as pointed out by the Attorney, an electronic procurement system may be used internally by an organization to aggregate its own demand, and thus may allow more flexibility in aggregating the demand (page 1 of Attorney's remarks).

The Examiner notes, the specification of the instant invention merely defines an electronic procurement system as a system that automates much of the purchasing process for a business, such as the creation and tracking of purchase orders (page 1 of the instant application as filed).

The Examiner further notes, the system as defined by Walker, according to one aspect of the invention, is an offer management system for receiving and processing

Art Unit: 3625

individual purchase orders from buyers for one or more goods and services (column 2, line 57 to column 3, line 7). Furthermore, as shown in Figure 1, the aggregate CPO management system preferably includes a central controller and one or more secured servers for communicating with one or more seller or buyer interfaces. The aggregated CPO management system may provide a given CPO to selected sellers based on the industry associated with the CPO or other predefined screening criteria, so that sellers only obtain CPOs that they may be interested in or are authorized to screen (column 6, lines 23-33). With this in mind the system as defined by Walker would be enabled to be used internally by an organization to aggregate its own demand, and thus may allow more flexibility in aggregating the demand.

The Examiner further notes, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., internal electronic procurement system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

Art Unit: 3625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A handwritten signature in black ink, appearing to be the initials 'MSG' followed by a stylized flourish.

MSG
Patent Examiner
October 4, 2004